

REMARKS – General

1. Claims **18-31** are pending in the present application.
2. Claim **30** is rejected under 35 USC 102 re *Paleiov, et al.* Applicant respectfully requests reconsideration in light of the fact that *Paleiov, et al.* does not clearly specify “said embedded computer has the means to convert voice signals to computer readable and storable data”. *Paleiov, et al.* does teach that the DTMF protocol system includes the means to input user data in the form of a voice data field (Col. 6, lines 66-67 and Col. 7, lines 1-3; Col. 8, Table II).

Although *Paleiov, et al.* do briefly mention “speech synthesis and speech recognition capabilities” (Col. 6, lines 66-67; Col. 8, lines 55-56), it is unclear from the description exactly how this technology would be used, except for “the voice output and input fields may have text payloads, which are respectively converted to or from audio signals by the subscriber unit” (Col. 8, lines 56-58). Applicant’s claim **30** specifies that the IVR menus that are to be displayed for the user, are converted directly and entirely from the voice IVR analog signals received from the IVR computer system, i.e. the voice IVR received data is automatically, and entirely translated into text data by the user’s telephone, and thereby displayed to the user for interaction.

3. A discussion of the *Paleiov, et al.* reference is believed to be helpful in evaluating the limitations Applicant has included in the claims **18-31**:
 - a. *Paleiov et al.* teaches a bi-directional protocol (Col. 2, lines 56-57; Col. 5, lines 24-28; Col. 6, lines 6-8; Col. 7, lines 38-41) that uses a protocol encoded in DTMF signaling, in both directions, to retrieve data fundamentals pre-stored in the user’s phone system, and to

format and to display text and graphical information for an associated IVR phone call.

- b. The IVR visual display layout of the data is predetermined (Col. 6, lines 4-17) using an authoring computer system (Fig. 1, element 29; Col. 7, lines 56-67), whereby the screen layout is determined and converted to the DTMF protocol's data elements, which are then stored in the IVR computer (Fig. 1, element 28; Fig. 3, step 52; Col. 7, lines 64-67). The IVR computer then transmits the encoded screen layout to the user upon initiation of a call by the user (Col. 5, lines 18-31; Col. 7, lines 15-22). Note that at no time does the user directly interact with the IVR authoring system (Fig. 1, element 29). The user interacts directly, and only with the IVR host (Fig. 1; Fig. 3; Col. 9, lines 2-7; Col. 9, lines 14-17).
- c. Furthermore, Applicant was unable to locate an embodiment in *Paleiov, et al.*, that includes the means for the user to browse IVR display data, without first connecting to the IVR system. *Paleiov, et al.* teaches that the DTMF protocol specifies the display layout and encoded data that the user's decoding box decodes (Fig. 1, element 36; Fig. 2, block 42; Fig. 3, block 56) and converts to displayable information, which the user interacts with. Because the CCITT DTMF specification is limited to sixteen (16) elements (i.e. the characters: 1, 2, 3, 4, 5, 6, 7, 8, 9, 0, A, B, C, D *, #), without a look-up table it would be impossible to display all characters, for example, that exist on a standard QWERTY keyboard. *Paleiov, et al.* teaches that the DTMF protocol, received from the IVR host (Fig. 1, element 28) is decoded by the user's decoding box (Fig. 1, element 36; Fig. 3, block 56) and is directly used to retrieve predefined display elements stored in the user unit's "factory-programmed memory 46" (Col. 7, lines 30-38). In extrapolation, if the user were to dump the *Paleiov, et al.* "factory-programmed memory 46", the user would not be able interpret any display screens without first receiving direct-

connect DTMF screen protocol data from the IVR system, for a particular phone number. In contrast, Applicant's claimed invention teaches the pre-storing of all text menus associated with a specific phone number's IVR menu system. Hence, by extrapolation, if a user were to dump the Applicant's claimed phone's embedded computer memory, then the user would be able to discern the textual IVR menus for a specific phone number. Furthermore, the Applicant's claimed invention does not require the IVR system to send DTMF tones in order for the user to receive, display and navigate any associated text menus.

- d. *Paleiov, et al.* teaches that all of the text and other graphical elements that could be used to display information to the user, i.e. data received in the specified encoded DTMF protocol, is pre-stored in the user's device's memory (Fig.2 element 46; Col. 2, lines 50-53), i.e. the "factory-programmed memory 46" (Col. 7, line 34). As far as the applicant understands from the *Paleiov, et al.* specification, the equivalent of a look-up table (Col. 2, lines 50-53) is stored in said factory-programmed memory, from which displayed elements are retrieved based on codes received from the IVR host using the specified DTMF protocol (Col. 2, lines 58-62). Applicant is unable to find any embodiment in *Paleiov, et al.*, that includes the capability to update said "factory-programmed memory 46". In contrast, Applicant's claimed invention includes said update capability of user's, locally pre-stored visual menu text data (Applicant claims 19, 22, 25 and 28).
- e. A general note that Applicant was unable to find any reference of the term "modem" in the *Paleiov, et al.* patent. Applicant did not find any discussion about using "a modem attached to said user embedded computer for receiving said text data to display visual menus and other data on said user embedded computer display screen from a source computer" (Office Action, discussion point [8]), from which the user's phone system can download updates, etc. that are used in an IVR call. By inference, it is understood that the user's phone system in *Paleiov, et al.* uses a DTMF "modem" in order to encode and

decode data in the specified DTMF protocol (Fig. 1). The problem with simply using a DTMF modem chip, such as Philips Semiconductors PCD3311C and PCD3312C “DTMF/modem/musical-tone generators”, is that it requires a protocol to be specified between both ends of the IVR communications in order for more than the standard CCITT DTMF characters (see discussion item [c] above) to be communicated. *Paleiov, et al.* in fact teaches using a bi-directional DTMF protocol (see discussion item [a] above). In contrast, Applicant’s claimed invention uses standard, off-the-shelf, analog modems (e.g. V.90 and V.92) and broadband modems (e.g. for ADSL, cable, etc.) to transmit any and all binary data, including ASCII text, without the need of an additional protocol, etc. from said source computer to said user telephone.

4. Applicant submits that these differences discussed above are reflected in the claims and respectfully requests any suggestions by the examiner in further clarifying these distinctions so that the claims may be allowed.
5. Claims 19-23, 25-29 and 31 depend from presumably allowable independent claims and should be allowed for at least that reason.
6. Rejection of claims 18-31 under 35 USC 103(a) as being unpatentable over *Paleiov, et al.* in view of *Rosen, et al.*, is overcome because *Paleiov, et al.* and *Rosen, et al.* do not contain any justification to support their combination, much less in the manner proposed. With regard to the proposed combination of *Paleiov, et al.* and *Rosen, et al.* it is well known that in order for any prior art references themselves to be validly combined for use in a prior art USC 103 rejection, the references themselves (or some other prior art) must suggest that they be combined. For example, it was stated in In re Sernaker, 217 U.S.P.O 1,6 (C.A.F.C. 1983):

“[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage

be derived from combination of their teaching.”

That the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S.P.O. 193, 199 (C.A.F.C. 1983):

“It is wrong to use the patent in suit [here the patent application] as a guide through a maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO].”

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.O. 2d 1434 (C.A.F.C. 1988):

“[w]here prior-art references require selective combination by the court to render obvious a subsequent patent , there must be some reason for the combination other than the hindsight gleaned from the invention itself..... Something in the prior art must suggest the desirability and thus the obviousness of making the combination.”

Furthermore, in the last O.A. the reason given to support the proposed combination is:

“*Rosen et al.* teach that the pre-stored text data comprises location data of said source computer on said computer communications network”.

Rosen et al. does not teach that the location data of the source computer, i.e. the resource server (Fig. 1, element 120 in *Rosen et al.*) is stored locally in the “user interface device 133”.

Rosen et al. teaches that a geographic location device (Fig. 1, element 132) communicates the user interface device's location to a resolution server (Fig. 1, element 110; Fig. 2; Col. 4, lines 44-61 and Col. 5, lines 6-27) via a communications network (Fig. 1, element 100). The resolution server stores the "location data of said source computer", i.e. the resolution server 110 in *Rosen et al.* In contrast, Applicant's claimed invention teaches the pre-storing of location data for said source computer, in said embedded computer memory of the user's telephone. Hence obviating the need to connect to the IVR system via a communications network, to retrieve the location data of the said source computer.

Applicant therefore submits that combining is not legally justified and is therefore improper. Thus Applicant submits that the rejection on these references is also improper and should be withdrawn.

Conclusion

For all of the above reasons, Applicant submits that the claims all define patentability over the prior art. Therefore, Applicant submits that this application is now in condition for allowance, of which action is respectfully solicited.

Request For Constructive Assistance

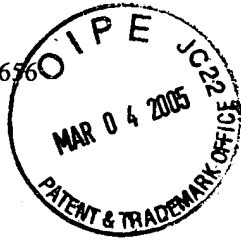
The undersigned has made a diligent effort to amend the claims of this application so that they define a novel method, which is also submitted to render the claimed method unobvious because it produces new and unexpected results. If, for any reason the claims of this application are not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more claims pursuant to **MPEP 707.07(j)**, or in making constructive suggestions pursuant to **MPEP 706.03(d)** in order that this application can be placed in allowance as soon as possible and without the need for further proceedings.

Very Respectfully,

A handwritten signature in black ink, appearing to read 'L. Sussman', with a stylized flourish at the end.

Lester Sussman

Applicant Pro Se



Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to:
"Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 2005, March 2

Lester Sussman, Applicant